

**REMARKS**

Applicants have carefully considered the November 7, 2003 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 1-4 and 7-10 are pending in this application. In response to the Office Action dated November 7, 2003, claims 1, 2 and 9 have been amended. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed claims and disclosure, including Figures 1, 2, 4 and 6. Applicants submit that the present Amendment does not generate any new matter issue. Entry of the present Amendment is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

Claims 1-4 and 7-10 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 7-10 of copending U.S. Application No. 10/208,838 (hereinafter “‘838 application”). This rejection is respectfully traversed. Contrary to the Examiner’s assertion, claims 1-4 and 7-10 are not pending in the ‘838 application, but rather, were previously canceled. Thus, for at least these reasons the provisional rejection is not legally viable. Moreover, Applicants submit that the provisional double patenting rejection is not sustainable over pending claims 13, 14, 17 and 19 in the ‘838 application. Applicants, therefore, respectfully solicit withdrawal of the imposed rejection of claims 1-4 and 7-10 in the instant application.

Claims 1-4 and 7-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson (U.S. Pat. No. 5,552,709) in view of Oka et al. (U.S. Pat. No. 6,169,402, hereinafter "Oka"). Applicants respectfully traverse.

The Examiner asserted that Anderson discloses the claimed invention but for a magnet including a paired split magnets for generating a magnetic field in a horizontal direction. The Examiner asserted that Oka, at Fig. 5, discloses the use of split magnets for generating a magnetic field in a horizontal direction and concluded that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Oka's split magnets with Andersons NMR spectrometer for liquid solution "for the purpose of applying a distributed main field in a horizontal direction to the sample." Applicants respectfully traverse.

As acknowledged by the Examiner, Anderson does not disclose the paired split magnets for generating a magnetic field in a horizontal direction. Applicants note that Anderson, at Fig. 1, discloses that a static magnetic field is generated in a vertical direction. See B0 in Fig. 1. Applicants submit that the Examiner's has failed to provide any fact-based reason as to why one of ordinary skill in the art would have turned to Oka to remedy the deficiencies of Anderson. The Examiner has only offered a conclusory statement that the proposed combination would result in the application of a distributed main field in a horizontal direction to the sample, but has not provided any objective evidence to support this conclusion. Anderson discloses that the static magnetic field is generated in a vertical direction. In contrast, Oka discloses that the static magnetic field is generated in a horizontal direction. With the Examiner's proposed combination, Anderson's NMR apparatus would have to be set transversely and the sample would need to be inserted in a

horizontal direction. However, the Examiner has failed to provide any objective explanation as to how Anderson's apparatus could be rearranged in such a manner. The factual question of motivation cannot be resolved on subjective belief of the Examiner and unknown authority, but must be based on objective evidence of record. *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002). Obvious to try is not the standard. *In re O'Farrell*, 853 F.2d 894, 7 USPQ2d 1673 (Fed. Cir. 1988). Thus, for at least this reason the rejection is not sustainable and should be withdrawn.

Moreover, Applicants submit that Anderson is silent as to a superconductor magnet including, a first and second space with respect to the magnets, as now required in each of independent claims 1, 2 and 9. Similarly, Oka fails to teach or remotely suggest a second space along the horizontal magnetic field. In Oka, since superconducting bulk is used, it is impossible to create a space in a horizontal direction. Thus, even if combined, the references fail to disclose or remotely suggest all of the limitations of independent claims 1, 2 and 9. For this reason alone the rejection is not legally viable and should be withdrawn.

By way of example, when the superconductive magnet is formed as the paired split magnets for generating a magnetic field in the horizontal direction, it can be combined with a solenoid type reception coil. Further, though the magnet is set transversely, the liquid-solution sample can be inserted vertically in a direction perpendicular to the horizontal magnetic field. As a result, the NMR apparatus has very high sensitivity. See specification at page 9, line 22 through page 10, line 15. Further, since there is a second space along the horizontal magnetic field, openness is created in

an available space for a user. Because of this, a dynamic measurement of behavior of protein can be easily executed while a laser beam is irradiated.

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, if any, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees and/or any fee for the information disclosure statement, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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